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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/014,112	12/11/2001	Harold Aaron Lutke	SONY 3.0-020	3954
530	7590	09/16/2009	EXAMINER	
LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			KUCAB, JAMIE R	
ART UNIT	PAPER NUMBER			
		3621		
MAIL DATE	DELIVERY MODE			
09/16/2009	PAPER			

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/014,112	<b>Applicant(s)</b> LUDTKE ET AL.
	<b>Examiner</b> JAMIE KUCAB	<b>Art Unit</b> 3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 12 June 2009.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1,2,10,12,14,109,111,112 and 118-127 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) 1,2,10,12,14,109, and 123-127 is/are allowed.

6) Claim(s) 111,112 and 118-122 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination ("RCE") under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 12, 2009 has been entered.

***Acknowledgements***

2. In accordance with the RCE above, claims 1, 2, 10, 12, 14, 109, 111, 112, 118-127 are currently pending.
3. Claims 1, 2, 10, 12, 14, 109, 111, 112, 118-127 are examined below.
4. This Office action is given Paper No. 20090911 for reference purposes only.
5. Based on a comparison of the PGPub US 2002/0128980 A1 with Applicant's originally submitted specification, the PGPub appears to be a fair and accurate record of the Applicant's specification. Therefore, except where otherwise noted, references in this action to Applicant's specification refer to paragraph numbers in the PGPub.

***Specification***

6. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the specification lacks antecedent basis for the various means for recited in claims 111, 112, and 118-122.

***Claim Objections***

7. Claim 1 and 123 are objected to because of the following informalities: where Applicant recites "in response to determining that the generated unique biometric substantially matches one of the stored unique biometric traits", it appears that Applicant intends to recite -- in response to determining that the generated unique biometric trait substantially matches one of the stored unique biometric traits -- or similar. For the purpose of comparison with the prior art, the Examiner is taking it as such. Appropriate clarification or correction is required.

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 111, 112, and 118-122 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Regarding claims 111, 112, and 118-122, various "means for" are claimed, but they are not clearly linked to corresponding structure in the specification, as required by § 112, 6<sup>th</sup> paragraph.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12. Claims 111, 112, and 118-122 are rejected under 35 U.S.C. §103(a) as being unpatentable over Krishnan et al., U.S. Patent No. 6,073,124 in view of Shinn, U.S. Patent No. 6,655,585 and further in view of Pare, Jr. et al. (US Pat. No. 6,269,348 hereafter "Pare").

13. As per claims 111, 112, and 118-122, Krishnan et al. teach a system for effecting a transaction between a person and a provider over a network comprising:

- means for establishing a communication link over said network between a communication device (customer computer system 311 in figure 3) and a selected one of said plurality of providers (virtual store 304 and content supplier server 306 and licensing and purchasing broker 307 in figure 3) (column 3 line 45-48, column 8 line 26-58);

- means for acquiring, at said communication device, at least one purchase selection provided by the person (column 6 line 66 - column 7 line 1 or step 2101 in Fig. 2);
- means for transmitting (via HTTP request message), from said communication device to said selected provider, the at least one purchase selection (column 6 line 66 - column 7 line 5);
- means for receiving, at said communication device from said selected provider, an order form (WEB page Fig. 7, step 401 in figure 4) for carrying out a transaction based on the at least one selection (column 15 line 37-40);
- in response to determining that the generated unique identification trait substantially matches the stored unique identification trait:
  - means for locating, from among the plurality of files in the database, a file associated with the selected provider, retrieving, from the database, a credit card number of the person and personal information of the person that are stored in association with the located file (figures 14-16, column 19 lines 35-67, column 21 lines 15-21),
  - means for automatically completing, at said communication device, the received order form using the retrieved credit card number and the retrieved personal information (figure 17, column 21 lines 15-21), and
  - means for automatically transmitting, to the provider from said communication device, the completed form and a verification code (e.g. data encrypted by user's key) (figures 12 and 17; column 21, lines 50-61)

indicating that the generated unique identification trait and the stored unique identification trait substantially match (figure 15; column 10, lines 1-8; column 19, lines 35-67; column 21, lines 15-21).

14. However, Krishnan et al. do not explicitly recite means for generating, using a biometric device, a unique identification trait associated with the person and comparing, at said biometric device, the generated unique identification trait to the unique identification traits stored in a database.

15. Shinn teaches means for generating a unique identification trait (e.g. fingerprint) (column 3, lines 25-39) using a biometric device (e.g. PC, laptop, PDA, ATM, etc. - column 8, lines 25-35) (figure 5; column 8, lines 25-35) and in association with acquiring a credit card number and personal information (abstract; figure 5; column 8, lines 2-25), comparing at the biometric device the generated unique trait with a previously stored trait (abstract; figure 8, column 3, lines 25-35) and if the two traits match within a specified confidence level authorizing the transaction (abstract; column 8, lines 2-25; column 10, lines 1-13). Regarding a visual or audio indication to the user to provide a biometric sample, it is inherent that such an indication would exist otherwise the user would be able to make purchases without biometric verification a scenario that teaches away from the Shinn invention. Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Krishnan et al. and Shinn in order to prevent unauthorized users (such as users who have inappropriately obtained a credit card password belonging to another user- '124, figure 15, column 21, lines 2-9) from making purchases online purchases ('585, column 7, lines 24-29).

16. The combination of Krishnan/Shinn discloses all the elements of the claimed invention as detailed above, but Krishnan/Shinn fails to explicitly disclose means for storing, in a database, a unique identification trait of the person and a plurality of files associated with the unique identification trait of the person, the plurality of files being respectively associated with a plurality of providers such that a given one of the plurality of files is associated with a particular one of the plurality of providers.

17. However, Pare teaches means for storing, in a database ("biometric database"), a unique identification trait of the person and a plurality of files associated with the unique identification trait of the person, the plurality of files being respectively associated with a plurality of providers such that a given one of the plurality of files is associated with a particular one of the plurality of providers (C5 L1-48, Fig. 5 and associated text).

18. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the method/system of Krishnan/Shinn to include the storing of Pare in order to achieve the predictable result of efficient lookup of data based on the user's biometric data and thereby enable efficient transaction processing.

19. The Official Notice that online order forms are old and well known is taken to be admitted prior art. The Official Notice was asserted by the previous Examiner in the Office action mailed October 5, 2006. Applicant did not traverse this Official Notice in Applicant's next response filed December 18, 2006. Therefore, it is taken to be admitted prior art. See MPEP 2144.03.

***Allowable Subject Matter***

20. Claims 1, 2, 10, 12, 14, 109, and 123-127 allowed.
21. The following is a statement of reasons for the indication of allowable subject matter.

22. Regarding the claimed terms, the Examiner notes that a "general term must be understood in the context in which the inventor presents it." *In re Glaug* 283 F.3d 1335, 1340, 62 USPQ2d 1151, 1154 (Fed. Cir. 2002). Therefore the Examiner must interpret the claimed terms as found on pages 1-20 of the specification. Clearly, almost all the general terms in the claims may have multiple meanings. So where a claim term "is susceptible to various meanings, . . . the inventor's lexicography must prevail . . ." *Id.* Using these definitions for the claims, the claimed invention was not reasonably found in the prior art.

23. The closest art of record, Krishnan et al., U.S. Patent No. 6,073,124, in view of Shinn, U.S. Patent No. 6,655,585, and further in view of Pare, Jr. et al. US Pat. No. 6,269,348, discloses as previously discussed. However, the combination Krishnan/Shinn/Pare does not teach at least "storing, in a database, a plurality of unique biometric traits of the person and a plurality of provider files, the plurality of provider files being respectively associated with a plurality of providers and with the plurality of unique biometric traits such that each one of the plurality of provider files is unique to at most one of the plurality of providers and to at most one of the plurality of unique biometric traits." Moreover, the missing claimed limitation from Krishnan/Shinn/Pare is not found in a reasonable number of references. Yet even if the missing claimed limitation was

found in a reasonable number of references, a person of ordinary skill in the art at the time the invention was made would *not* have been motivated to include this missing limitation in the combination of Krishnan/Shinn/Pare because: such a change would destroy the functionality of the combination Krishnan/Shinn/Pare.

***Response to Arguments***

24. The Examiner expresses his appreciation for Applicant's citation on pg. 15 of the remarks filed June 6, 2008 of relevant portions of the specification where support for the amendments can be found. The Examiner's search for support for these amendments was not limited to these sections of the specification.

25. Applicant's arguments with respect to the drawing objections have been considered and they are persuasive. The drawing objections have been withdrawn.

26. Applicant's arguments with respect to the § 112, 1<sup>st</sup> paragraph rejections of the claims have been considered and they are persuasive. The § 112, 1<sup>st</sup> paragraph of the claims have been withdrawn.

27. Applicant's arguments with respect to the § 103 rejections of claims 1, 2, 10, 12, 14, 109, and 123-127 have been considered and they are persuasive. The § 103 rejections of these claims have been withdrawn.

***Conclusion***

28. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Jamie Kucab whose telephone number is 571-270-3025. The Examiner can normally be reached on Monday-Friday 9:30am-6:00pm EST.
29. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.
30. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JK

/EVENS J. AUGUSTIN/  
Primary Examiner, Art Unit 3621